

REMARKS

The indication that claims 12, 16, 17, 30, 38, 40 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, is acknowledged.

By the present amendment, in light of the indicated allowability of claims 38, 40 and 41, claim 38 has been written in independent form while incorporating some, but not all of the features of parent claim 37 in modified form, as will be discussed below, it being recognized that the Examiner has rejected claim 37 over cited art and at the same time, recognizing that the recited features of claim 38 are not disclosed or taught in the cited art. Accordingly, applicants submit that claim 38, as written in independent form and as will be discussed below, recites features not disclosed in the cited art and which should now be in condition for allowance. Additionally, objected to claims 40 and 41 have been amended to depend from what is now independent claim 38 with such claims being amended to conform to the language of claim 38 and applicants submit that claims 38, 40 and 41 should now be in condition for allowance.

Applicants note that claims 38, 40 and 41 are the only claims remaining in this application.

With respect to the other claims which stand rejected over cited art and which have been indicated as being objected to and allowable when rewritten in independent form, such claims have been cancelled without prejudice or disclaimer of the subject matter thereof, it being noted that the cancellation of such claims at this time does not represent an intention to abandon the claimed subject matter

which may be prosecuted in continuing applications. That is, such action has been taken in order to place this application in condition for allowance at this time.

With respect to the rewriting of claim 38 in independent form, applicants note that parent claim 37 referred to fifth and sixth recorder/reproducer means as well as fifth and sixth recording medium and while both claims 37 and 38 were writing in a means plus function format, by the present amendment, "means" language has been deleted from the claims while reciting the structural features in a manner which is considered to be in compliance with 35 USC 112, it being noted that claim 38, as presented now recites a digital recorder/reproducer apparatus having a first recorder/reproducer and a second recorder/reproducer for recording and reproducing signals on a first recording medium and a second recording medium rather than the recitation in claim 37 of "fifth" and "sixth". Furthermore, the portion of parent claim 37 reciting receiver means, compressed data generator means and expanded data generator means have been incorporated into claim 38 while deleting the "means" language. On the other hand, the previous recitation of claim 37 concerning recorder/reproducer means was considered to be a redundant recitation and the recitation of data selector means was considered to be an unnecessary limitation and have not been incorporated into the features of claim 38, it being recognized that claim 37 stands rejected over the cited art and the Examiner has recognized the patentability of the recited features of claim 38. Furthermore, claim 38 has been amended to also delete the "means" language and now recites a CM detector which detects the start and end points of commercials included in a television broadcast, it being recognized that page 41, lines 23 and 24 of the specification indicates that the CM predicting means 81 detects the start point and end point of CM such that clear basis is provided for the recitation of a "detector" in

claim 38. Additionally, claim 38 now recites a CM history memory which stores CM detected results, and a first controller which change the places for signals to be recorded and reproduced, of said first and second recording medium in accordance with said CM history information corresponding to the previously recited features of claim 38. Further the "whereby" clause from claim 37 has been presented as a wherein clause of claim 38 in revised form such that claim 38 now recites "wherein said second recording medium is reproduced while said compressed data is being recorded on said first recording medium. Thus, applicants submit that claim 38 has been written in independent form reciting the features of previous claim 38 which features have been recognized as being patentably distinguishable over the cited art with claim 38 being written in a form which is considered to be in compliance with 35 USC 112, such that applicants submit that claim 38 should now be in condition for allowance.

With respect to objected to claims 40 and 41, such claims have been amended to depend from claim 38 which should be in condition for allowance with such claims being amended to delete the "means" language while utilizing language conforming to the language of claim 38. Thus, by the present amendment, applicants submit that claims 38, 40 and 41, the only claims remaining in the application, should now be in condition for allowance.

As to the rejection of claims 1 - 9, 13, 18 - 21 and 33 under 35 USC 102(b) as being anticipated by Sata et al (US Patent 5,134,499); the rejection of claims 10 - 11, 14 - 15, 28 - 29 and 31 under 35 USC 103(a) as being unpatentable over Sata et al in view of Official Notice; the rejection of claims 22 - 24, 34 - 37 and 42 - 50 under 35 USC 103(a) as being unpatentable over Sata et al in view of Haines; the rejection of claims 25 - 27 under 35 USC 103(a) as being unpatentable over Sata et al and

Haines, further in view of Official Notice; the rejection of claim 32 under 35 USC 103(a) as being unpatentable over Sata et al and Official Notice and further in view of Haines; and the rejection of claim 39 under 35 USC 103(a) as being unpatentable over Sata et al and Haines and further in view of Freeman et al, such rejections have been obviated by the cancellation of such claims so that a discussion of the cited art with respect thereto is considered unnecessary. In this regard, applicants submit that the cancellation of the claims is not considered to be acquiescence in the propriety of the rejections as set forth nor acquiescing the taking of Official Notice. In this regard, it is noted that the objected to claims 12, 16, 17 and 30 have also been canceled by the present amendment.

Since only allowable claims 38, 40 and 41 remain in this application, applicants submit that this application should now be in condition for allowance and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 500.39051X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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